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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,053	09/27/1999	RICHARD L. PALINKAS	D-6394	2219

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RAYMOND D THOMPSON
UNIROYAL CHEMICAL COMPANY INC
WORLD HEADQUARTERS
MIDDLEBURY, CT 06749

EXAMINER
PEZZLO, BENJAMIN A

ART UNIT	PAPER NUMBER
3683	

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/407,053	PALINKAS, RICHARD L.	
	Examiner	Art Unit	
	Benjamin A Pezzlo	3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,3,5-8,10-15 and 17-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,3,5-8,10-15 and 17-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3, 5-8, 10-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079) in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a bearing pad assembly including a first housing 56 having an exterior surface and defining a bore extending at least part way through the first housing, a first load bearing member coupled to the housing (col. 3 lines 32-34) and defining an outwardly facing first abutment surface and a second housing 32 defining a bore of a shape similar to the exterior surface of the first housing and adapted to slidably receive the first housing therein, a second bearing member 42 coupled to the second housing and defining an outwardly facing second abutment surface opposite to the first abutment surface (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring 36 positioned within the first housing bore, wherein the compression spring comprises a resilient material having a toroidal shape.

Carlston does not disclose the toroidal shaped compression spring being solid. Magowan discloses a solid toroidal compression spring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a solid toroid according to the

teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13). Note that the solid toroid of Magowan is provided with an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Carlston in view of Magowan do not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirous to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirous to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 3, see Fig. 3 of Carlston.

Re claims 5-6, see Carlston: col. 2 lines 19-26.

Re claim 7, see Carlston: Fig. 6.

Re claim 8, see Carslton: Fig. 2.

Re claims 10-11, see generally Platkiewicz et al. col. 3 lines 2-6 and col. 1 lines 19-23.

Re claim 12, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

Re claim 13, see Platkiewicz et al. col. 3 line 63.

Re claim 14, see Platkiewicz et al. col. 3 line 64.

Re claim 17, see Carlston, Fig. 2.

Re claim 18, see Magowen, Fig. 2.

3. Claims 15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079).

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring in the shape of a toroid positioned within the first housing bore.

Carlston does not disclose the toroidal shaped compression spring being solid. Magowan discloses a solid toroidal compression spring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a solid toroid according to the

teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13). Note that the solid toroid of Magowan is provided with an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Re claim 19, see Carlston: springs 36, 38 in Fig. 2.

Re claim 20, see Carlston: "plate" 75 in Fig. 2.

4. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlston (US 4998997) in view of Magowan (US136079) in view of Platkiewicz (US 4465799) and further in view of Curtis (US 5036774) and Spencer et al. (US 5086707).

Carlston discloses a side bearing unit for a railroad car including a first housing 56 having a bore extending through the first housing, a first load bearing member coupled to the first housing (col. 3 lines 32-34) and defining an abutment surface opposite to the first housing, a second housing 32 having a bore extending through the second housing, adapted to telescopically receive the first housing, a second load bearing member 42 coupled to the second housing and defining an abutment surface opposite to the second housing (col. 3 lines 3-6 and col. 4 lines 34-36), and at least one compression spring in the shape of a toroid positioned within the first housing bore.

Carlston does not disclose the toroidal shaped compression spring being solid. Magowan discloses a solid toroidal compression spring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a solid toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means

with a high degree of elasticity but also with great economy and cheapness (Magowan: col. 1 line 9-13). Note that the solid toroid of Magowan is provided with an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Carlston does not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. Platkiewicz et al. disclose a low friction slide lining composition and a method of producing the slide lining composition. Curtis et al. disclose a long travel side bearing for an articulated railroad car, see Fig. 6, including spacers 64, 65 and Spencer et al. disclose self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a slip lining as taught by Platkiewicz et al. between the first housing and a bore wall defining the second housing bore in order to "improve utilization of slide surfaces" (Platkiewicz et al.: col. 1 lines 59-60). Curtis et al. and Spencer et al. provide further motivation to combine Carlston and Platkiewicz et al. Specifically, Curtis et al. teach that it is desirous to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68), and Spencer et al. teach that it is desirous to "automatically adjust and compensate for wear between cap and base parts" (Spencer et al.: col. 1 lines 57-58).

Re claim 22, see generally Platkiewicz et al. col. 2 line 67, "rubbing pair". Also see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere duplication of parts has no patentable significance unless a new and unexpected result is produced".

Response to Arguments

5. Applicant's arguments filed 4 November 2002 have been fully considered but they are not persuasive.

In the last sentence of the second paragraph of page 4, Applicant admits that Magowan teaches a solid torus shaped spring but alleges that the Examiner has not identified a motivation or suggestion to combine the spring of Magowan with the side bearing unit of Carlston.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner cited motivation to combine Magowan and Carlston in the Office Action Paper No. 16 on page 3 in the last sentence of the second paragraph: "in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness".

Applicant further argues that Carlston teaches away from a combination with Magowan because Carlston provides a hollow spring specifically designed to fold and flex under load and provide a flat force versus travel curve. However, Applicant has merely identified Carlston's invention. Prior to Carlston, there was Magowan who used a solid torus. A solid torus is a cheap and economical spring which provides a high degree of elasticity. So, instead of using Carlston's hollow spring, it would have been obvious to one of ordinary skill in the art to which

the invention pertains at the time the invention was made to have used the solid spring of Magowan for it's cheapness, economy, and elasticity.

Applicant argues that the combination of Carlston and Magowan would render Carlston's device unsatisfactory for it's intended purpose. The Examiner respectfully disagrees. A Carlston bearing unit with a Magowan spring would function as a side bearing pad.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A Pezzlo whose telephone number is (703) 306-4617. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BAP
November 14, 2002

JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
11/14/02